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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ALAIN LEAS,  
JONATHAN DAVID MASTNY,  
ADRIANUS CORNELIS KRUIK,  
ROBERT JOHN MAZUREK, and  
SHIRDAN JOSEPH GRYKIEWICZ

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Appeal 2010-001366  
Application 10/797,373  
Technology Center 1700

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Before TERRY J. OWENS, TONI R. SCHEINER, and MARK NAGUMO,  
*Administrative Patent Judges.*

NAGUMO, *Administrative Patent Judge.*

**DECISION ON APPEAL<sup>1</sup>**

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

**A. Introduction<sup>2, 3</sup>**

Alain Leas, Jonathan David Mastny, Adrianus Cornelis Kruik, Robert John Mazurek, and Shirdan Joseph Grykiewicz (“Nestec”) timely appeal under 35 U.S.C. § 134(a) from the final rejection<sup>4</sup> of claims 1-4, 8-10, and 25-37, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

The subject matter on appeal relates to a frozen confection formed in a transparent wrapper. The confection is provided with an open-ended shell made of a fat-based material such as chocolate, and the shell is filled with a frozen confection such as ice cream. The shell is further required to be provided with a decorative pattern formed from a mesh of strings of a first confection material, the spaces between the strings being filled with a differently colored second confection material. The outer surface of the shell is “substantially smooth.” In embodiments, the decorative pattern may comprise words, symbols, logos, etc. The outer surface of the shell is “substantially smooth.”

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<sup>2</sup> Application 10/797,373, *Packaged Decorated Frozen Confection and Method of Manufacture*, filed 9 March 2004, as a continuation-in-part of an application filed 10 March 2003, now abandoned. The specification is referred to as the “373 Specification,” and is cited as “Spec.” The real party in interest is listed as Nestec, S.A. (Appeal Brief, filed 13 January 2009 (“Br.”), 1.)

<sup>3</sup> A request for hearing was withdrawn 16 June 2010.

<sup>4</sup> Office action mailed 29 April 2008.

Representative Claim 1 reads:

1. A packaged decorated composite frozen confection product comprising:

an open-ended shell made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein, the shell wall having a substantially smooth outer surface;

a decorative pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings;

a packaging sleeve for protecting all of the outer surface of the shell, with the packaging sleeve formed in a shape that corresponds to the desired shape of the outer surface of the shell and having an inner surface that is in contact with the outer surface of the shell to form and display the pattern; and

a filling of a frozen confection at least in the interior volume of the shell;

wherein the entire packaging sleeve is transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve.

(Br., Claims App. p. 1 (pages not numbered); indentation added.)

Claim 9 depends from claim 1 and adds the further limitation that “the decorative pattern design includes a writing, script, a logo or a symbol.”

(*Id.* p. 2.)

The Examiner has maintained the following grounds of rejection:<sup>5</sup>

A. Claims 1-4, 8, 10, 25-28, and 30-33 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Krein,<sup>6</sup> D’Amato,<sup>7</sup> and Kuehl.<sup>8</sup>

B. Claims 9, 29, and 34-37 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Krein, D’Amato, Kuehl, Newsteder,<sup>9</sup> Palmer,<sup>10</sup> and Phillips.<sup>11</sup>

Nestec focuses the arguments for patentability on claim 1, arguing that the Examiner failed to establish a motivation to combine the references, and that there is no suggestion of the claimed invention in the references themselves. (Br. 14.) More specifically, Nestec argues that “Krein was primarily interested in providing an efficient and economic method of making a frozen confectionary product with a chocolate coating in a temporary wrapper.” (*Id.* at 16.) Nestec also points out that the temporary wrappers described by Krein are not transparent. Moreover, according to Nestec, “[t]ransparent packaging wrappers were known and available at the

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<sup>5</sup> Examiner’s Answer mailed 5 March 2009. (“Ans.”).

<sup>6</sup> Frederick Thomas Krein, *Method of Making Frozen Confections*, U.S. Patent 2,106,893 (1938).

<sup>7</sup> Salvatore D’Amato, EP 0 276 333 (1987).

<sup>8</sup> Edward Kuehl et al., *Marbled Confectionery Coating*, EP 0 848 910 A2 (1998).

<sup>9</sup> Robert Newsteder, U.S. Patent 4,778,683 (1988).

<sup>10</sup> Stephen L. Palmer and William R. Palmer, U.S. Patent Application Publication US 2003/0099746 A1 (29 May 2003), based on an application filed 9 October 2001.

<sup>11</sup> Charles A. Phillips and Mortimer D. Phillips, U.S. Patent 5,035,907 (1991).

time of Krein's disclosure." (*Id.* at 19.) Nestec concludes that it was not obvious to use transparent packaging wrappers because Krein's main objective was to provide an economical wrapper. (*Id.* at 20.) Nestec acknowledges that Krein describes an ice cream product having a two-tone color effect, but emphasizes that because that "visual effect" is "produced after stripping the opaque wrapper, such visual effect is clearly incidental." (*Id.* at 16.)

Nestec criticizes the Examiner's reliance on D'Amato because D'Amato teaches an ice confection that is placed in a transparent packaging after the confection has been made. As a consequence, according to Nestec, "there can be no complete surface-to-surface contact between the ice confection and the packaging as recited in the present claims." (Br. at 17.) Moreover, according to Nestec, D'Amato "appears to teach advertising on the transparent material." (*Id.* at 16.) The presence of such matter would, Nestec argues, interfere with the display of the pattern of the confection, in contrast to the claimed product. (*Id.* at 17.)

Nestec argues that Kuehl, despite the disclosure of a chocolate coating having a marbled appearance, is not relevant to the determination of obviousness because Kuehl does not teach a packaging sleeve for the confection, but rather prepares the confection in a mold. (Br. at 18.) Kuehl, according to Nestec, is therefore not concerned with a chocolate shell having a smooth surface that is in complete surface-to-surface contact with a transparent packaging sleeve. (*Id.*)

The Examiner finds that Krein teaches forming a chocolate shell, which may be two-toned and have a highly attractive color effect, in a paper

shell that may be waxed paper (Ans. 4), which, the Examiner finds, is not transparent (*id.* at 5). The Examiner finds that D'Amato teaches that using a transparent foil for frozen confections having a conical shape provides a more consumer friendly packaging, because the consumer can freely view the ice cream in the packaging. (*Id.* at 5.) The Examiner argues that it would have been obvious to use a transparent material for packaging in place of the opaque paper used by Krein to improve the marketability of the product. (*Id.*) The Examiner relies on Kuehl for teachings of providing an edible shell having a decorative pattern design comprising a mesh of strings of a first material with a second material between the strings of the first material. (*Id.* at 6.) According to the Examiner, Kuehl teaches that the shell is formed such that a smooth surface is formed. (*Id.*) The Examiner concludes it would have been obvious to provide such a pattern in a transparent wrapper as would have been obvious in view of the teachings of Krein and D'Amato. (*Id.*) The Examiner relies on the further cited references as evidence that writings, scripts, logos, or symbols would have been obvious to add to the designs of the shells, but as these arguments are not substantively traversed, we need not describe them further.

## **B. Discussion**

Findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

Nestec does not contest the Examiner's findings of fact regarding the individual references. Rather, Nestec objects to the combination of teachings from the references. Because Nestec does not present distinct

arguments for the patentability of any claim other than claim 1, all claims stand or fall with claim 1.

Nestec's arguments are not persuasive of harmful error in the Examiner's rejections because Nestec does not address the arguments made by the Examiner. Instead, Nestec appears to assume that the Examiner has erred by failing to bodily combine features of the embodiments taught by the references. As the predecessor to our reviewing court explained some three decades ago,

[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

*In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted). Thus, Nestec appears to assume that the only rejection the Examiner could make is that it would have been obvious to use the particular plastic mold taught by D'Amato in place of the wrapper described by Krein. In so doing, Nestec has not shown harmful error in the Examiner's contention that it would have been obvious to use a transparent wrapper in place of the waxed paper cone used by Krein. Nor has Nestec shown harmful error in the Examiner's argument that, following the suggestions of Kuehl, it would have been obvious to form, on the inner surface of the transparent wrapper, a two-toned decorative cone from strings of chocolate and a second chocolate material to fill in the spaces between the strings. Nestec has not explained why such a method would not have provided—in the same way as the 373 Specification



describes making the shell for the claimed packaged frozen confection—a smooth outer coat “in complete surface-to-surface contact with the transparent packaging sleeve.”

The nearest Nestec appears to come to addressing the Examiner’s proposed substitution is to argue that it was apparently not obvious to use the transparent wrappers admittedly available to Krein [in the mid-1930s] because transparent wrappers were too expensive. (Br. 19-20.) This argument appears to be based on Nestec’s assumption that “the considerations appropriately taken into account would be those prevalent at the time of Krein’s invention, and not at the time of Appellants’ invention.” (Br. 21.) This assumption, however, is without merit. The time at which obviousness is to be evaluated is set by statute to “the time the invention was made.” 35 U.S.C. § 103. The “invention” referred to in § 103 is, of course, the invention for which patent protection is sought, not some invention described in the prior art. Thus, the materials that a person having ordinary skill in the art would considered as potential substitutes for wax paper wrappers are those available at the time Appellants made their invention, i.e., circa March 2004, the filing date of the 373 Application. Moreover, considerations of costs and economies, which Nestec argues would have taught away from modifying Krein (Br. 20), are irrelevant because claim 1 does not include costs and economies as any sort of limitation on the claimed article of manufacture. Only “technical” issues of obviousness, such as enablement of the references, or the propriety of combining their teachings, are germane to considerations of patentability of claim 1.

In this regard, Nestec's objection that the transparent package described by D'Amato would not provide the complete contact required by the claims is inapposite. The Examiner does not suggest that a person having ordinary skill in the relevant arts would have attempted to provide a pre-formed wrapper to fit a shell-encased frozen confection. Rather, the Examiner argues that it would have been obvious to form the shell for the frozen confection in a transparent wrapper. Similarly, the Examiner argues that the artisan would have adopted the method of forming shells with string-like mesh designs to the method taught by Krein. Nestec's arguments that using the machinery taught by Kuehl could not result in a smooth outer surface in complete contact with a packaging sleeve (Br. 23) again misapprehend the Examiner's argument.

Finally, we find Nestec's arguments for unexpected results unpersuasive. Nestec argues that it would have been unexpected that consumers would better appreciate the visual attractiveness of the decorative designs because the frozen confections are provided in a transparent packaging sleeve. (Br. 17) Transparent packaging materials have been a staple of displays for items on sale as long as transparent packaging materials have been available. The suggestion by D'Amato that an ice cream cone could be presented in a transparent wrapper would have also suggested, to persons having ordinary skill in the art, all the allegedly unexpected advantages of product visibility. Nestec has not come forward with any credible evidence to the contrary.

We conclude that Nestec has failed to show harmful error in the Examiner's rejections.

**D. Order**

We AFFIRM the rejection of claims 1-4, 8, 10, 25-28, and 30-33 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Krein, D'Amato, and Kuehl.

We AFFIRM the rejection of claims 9, 29, and 34-37 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Krein, D'Amato, Kuehl, Newsteder, Palmer, and Phillips.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

**AFFIRMED**

sld

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